

Appln. No. 09/987,701
Amd. dated December 1, 2004
Reply to Office Action of September 8, 2004

REMARKS

The Office Action and the cited and applied reference have been carefully reviewed. No claim is allowed. Claims 1, 2, and 5-9 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

The specification is now amended to place the claim for priority as the first sentence of the specification.

The objection to the disclosure for lacking sequence identifiers for Figs. 5A-5B in the Brief Description of the Drawings is obviated by appropriate correction to the specification.

Claims 1-7 have been rejected under 35 U.S.C. §101 as being drawn to non-statutory subject matter. The claims are now amended to recite an "isolated" polypeptide, thereby obviating this rejection.

Claims 1 and 3 have been rejected under 35 U.S.C. §102(b) as being anticipated by Bassi et al. The examiner states that Bassi teaches TBL1 protein (Figure 2) which allegedly has 89.4% sequence identity to SEQ ID NO:2 according to the sequence comparison attached to the Office Action.

Claim 3 is now canceled and claim 1 is amended to incorporate the recitation of "at least 90% sequence identity" from canceled original claim 4. Applicants respectfully point

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out that the 89.4% query match in the sequence comparison provided by the examiner does not refer to sequence identity as recited in the present claims, but rather to sequence homology, which is different. This can be seen clearly from page 3 of the sequence comparison where a length of 526 amino acids is compared. Within this length of 526 residues, there are 453 matches for a sequence identity of $(453/526) \times 100\% = 86.1\%$. The remaining residues are either mismatches or conservative "substitutions", which are not considered for purposes of "identity" in sequence identity comparisons, as would be well recognized by those of skill in the art. Because the calculated sequence identity is much lower than the recited "at least 90% sequence identity", claim 1 cannot be anticipated by Bassi.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 1, 3, and 8-9 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bassi. The disclosures and teachings of Bassi are stated by the examiner as in the above §102(b) rejection. The examiner takes the position that while Bassi does not specifically disclose an antibody to the TBL1 protein, the presently claimed invention is obvious because of applicant's admission that the polypeptide taught by Bassi renders antibodies specific for the polypeptide *prima facie* obvious. This rejection is respectfully traversed.

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The claims are now amended to recite "at least 90% sequence identity". As the TBL1 protein of Bassi does not have "at least 90% sequence identity" to SEQ ID NO:2, then there is no *prima facie* case of obviousness and Bassi cannot make obvious the present invention by leading one of ordinary skill in the art to the presently claimed invention. Accordingly, reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

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By

A handwritten signature in black ink, appearing to be "Allen C. Yun", written over a horizontal line.

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